

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Reply, claims 35-44 have been added and claim 32 has been amended. Claims 2-6, 9-12 and 21-26 were previously canceled without prejudice or disclaimer of the subject matter therein. Also, claim 30 is allowed, and claims 13 and 30 are indicated to be allowable (at page 5 of the outstanding Office Action). Thus, claims 1, 7-8, 13-20 and 27-44 are pending in the present application. Applicants further note that claims 1, 16, 18, 20 and 30-34 are independent product claims, and claims 7 and 27 are independent method claims.

No new matter has been added by way of these new claims, because each new claim is supported by the present specification. For example, the addition of claims 35-36, which recite the "harvested plant," has support in the specification at page 2, lines 13-14. Support for new claims 37-44, which define component (A) as the "alkyl polyglycoside . . .", have support at least at page 6, lines 8-9 and 15-20 of the present specification. Thus, no new matter has been added.

No new matter has been added with the amendment to claim 32. The incorporated subject matter is supported by, e.g., the component (C) as instantly recited in claim 1.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Substance of Interview

Applicants thank Examiner Pryor for his time, helpfulness and courtesies extended to Applicants' representative during the Interview of April 4, 2006. The assistance of the Examiner in advancing prosecution of the present application is greatly appreciated. In compliance with M.P.E.P. § 713.04, Applicants submit the following remarks.

During the Interview, Applicants argued that the newly cited references are improperly combined and/or cited. Specifically, Applicants argued that Nonomura *et al.* '104 (U.S. Patent No. 5,958,104), JP '032 (JP 5111032) and JP '310 (JP 63033310) are directed to a different use of plant growth, and that Nonomura '104 list "fungicides" among a laundry list of ingredients. Applicants added that Sakai *et al.* '801 (JP 02209801) does not disclose the instantly claimed component (C). Applicants also mentioned they would be adding dependent claims, which includes the new claims 35 and 36 as presented herein. Applicants' more specific arguments are presented below.

Issues Under 35 U.S.C. § 103(a)

Claims 1, 7, 8, 14-16, 18, 19, 27-29, 31 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonomura *et al.* '104 (U.S. Patent No. 5,958,104), JP '032 (JP 5111032) and JP '310 (JP 63033310) (see pages 2-4 of the Office Action).

Also, claims 1, 7, 15, 17-20, 27-29 and 32-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakai *et al.* '801 (JP 02209801).

These rejections are respectfully traversed, and reconsideration and withdrawal of these rejections are respectfully requested.

Distinctions over the Combination of Nonomura '104, JP '032 and JP '310

Applicants respectfully submit that Nonomura '104, JP '032 and JP '310 have been improperly combined.

The Examiner cites the primary reference of Nonomura '104 as disclosing certain components to match what is instantly claimed (with reference to the Abstract and parts of columns 2, 4, 5 and 7 of the reference). Then, the deficiencies of Nonomura '104 are accounted for by citing the secondary references of JP '032 and JP '310 (e.g., JP '032 is used to disclose the claimed components (D) and (F)).

Still, Nonomura '104 merely discloses enhancement of plant growth. Regarding such disclosure, one of ordinary skill in the art would understand that Nonomura '104 is directed to increasing the size of the plant (or just enhancing the growth of the plant) (see, e.g., column 1, lines 63+). Also, the plant to be treated in the Nonomura '104 reference is defined as a vivid

plant, wherein this reference focuses on carbon fixation (see, e.g., column 3, lines 59+). However, Applicants note that the instantly pending method claims are directed to keeping the freshness of a plant. In addition, Nonomura '104 describes its surfactant as an alkyl glycoside having 1-7 carbon atoms, but there is no disclosure regarding any ester/amide (please see column 2, lines 3-9). This is another distinction from the present invention. Additionally, Applicants respectfully submit that one of ordinary skill in the art, based on such descriptions in Nonomura '104, would not combine the Nonomura '104 primary reference with JP 032 and/or JP '310.

The cited JP '032 reference merely shows an insecticide or herbicide, or enhancing of the growth of a plant, using calcium cyanamide or cyanamide of formula (I) (see English Abstract). There is no referral or description in JP '032 regarding a surfactant as instantly claimed.

Similarly, JP '310 merely describes enhancement of plant growth (with active component chitin or chitosan) without any reference or description regarding a surfactant as instantly claimed.

In combining Nonomura '104 with JP '032, the Examiner states it would be obvious "to modify the invention taught by Nonomura to include the cyanamide and hydrox-5-methyl-ixooxazole taught by JP '032 . . . since Nonomura suggests the addition of fungicides to his invention" (page 3, lines 4-6 from the bottom of the Office Action). Also, in combining Nonomura '104 with JP '032 and JP '310, the Examiner states it would be obvious to do so since "One would have been motivated to do this in order to promote the growth of the plant at the root" (see page 4, lines 4-9 of the Office Action). Applicants respectfully disagree and submit that the skilled artisan would not combine the disclosure of the three references in order to

achieve what is instantly claimed. Applicants add that the requisite motivation in forming a *prima facie* case of obviousness is lacking. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

In combining Nonomura '104 with JP '032, Applicants note that column 7, lines 9-30 of Nonomura '104 (as cited in the Office Action) includes a huge laundry list of optional ingredients. Thus, Applicants respectfully disagree that it is not proper to suggest that the requisite motivation is met in forming a *prima facie* case of obviousness by stating "Nonomura suggests the addition of fungicides to his invention." The Nonomura '104 reference merely discloses that "various secondary nutrients," "micronutrients," etc., may optionally be included (see Col. 7, lines 9+). Applicants respectfully submit that the requisite motivation is lacking, and that this part of the Nonomura '104 reference does not equal disclosure to achieve the present invention because options presented amounts to an "obvious to try" rationale. Such an "obvious to try" rationale is improper for an analysis of patentability under § 103(a). *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (CAFC 1988) (In *In re Fine*, the CAFC reversed the BPAI by stating: "The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art," *but neither of them offered any support for or explanation of this conclusion.*") (emphasis added); *see also In re Deuel*, 34 USPQ2d 1210, 1216 (CAFC 1995) (where the court states: "Obvious to try" has long been held not to constitute obviousness. A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can

be carried out”) (citing *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-1681 (CAFC 1988)).

Similarly, adding the disclosure of JP '310 does not make the instant combination of reference any more proper. An “obvious to try” rationale is still being used to combine all three references together.

Likewise, it is noted that an “invitation to explore” cannot form a basis for an Examiner’s rejection under 35 U.S.C. § 103(a). *See Ex parte Obukowicz*, 27 USPQ2d 1063 (B.P.A.I. 1992). In other words, picking and choosing elements from several references to achieve the presently claimed combination of ingredients (A)-(F) equals an impermissible invitation to explore.

Further, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999); *see also* M.P.E.P. § 2143.01. In forming the instant rejection, Applicants respectfully submit that the Examiner has improperly used the level of skill in the art to combine the disclosures of Nonomura '104, JP '032 and JP '310. For instance, the reference to promoting plant growth as a basis for combining Nonomura '104/JP '032 with JP '310 is simply referring to the level of skill in the art.

Applicants note that if wanting to promote plant growth was the only motivation needed to combine the three references, many different references (patents or publications) could or would be combined until the present invention is eventually achieved. However, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *See In re Vaeck*, 947 F.2d 488,

20 USPQ2d 1438 (Fed. Cir. 1991). That is not the case here given, e.g., the laundry list of optional ingredients that may be added to the Nonomura '104 embodiment. Applicants add that the mere fact that disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. *See, In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and *In re Imperato*, 179 USPQ 730, 732 (CCPA 1973). That is also not the case here for the same reasons presented above.

In fact, Applicants respectfully submit that the Examiner is unreasonably interpreting the language of Nonomura '104 too broadly. While patents are relevant as prior art for all they contain, they cannot be relied upon to teach embodiments that are not reasonably suggested to one having ordinary skill in the art. *See Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804 (Fed. Cir. 1989). In this regard, Applicants submit that Nonomura '104 does not teach adding any ingredient disclosed in JP '032 and/or JP '310.

Applicants further note that enhancing plant growth, as disclosed in all three cited references, does not equal the claimed methods directed to promoting plant freshness. This is another reason as to why the instant rejection is improper.

Finally, Applicants note that the secondary references do not even suggest the instantly claimed component (A). Thus, the requisite motivation and/or reasonable expectation are lacking when one of ordinary skill in the art would not believe that merely inserting the JP '032 ingredient into the Nonomura '104 embodiment would even work.

Thus, this rejection under § 103(a) has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Distinctions over the Modification of Sakai '801

Applicants submit that the cited modification of Sakai '801 is improper.

Sakai '801 shows controlling growth of a vivid plant with reference to brassinolides, POE sorbitan fatty acid ester and isopropanol (see the English Abstract). However, the disclosed brassinolide in Sakai '801 does not match the instantly claimed component (C) as asserted in the Office Action. More specifically, the present invention does not include a brassinolide and/or Sakai '801 fails to disclose any alkylglycoside as instantly claimed (see, e.g., lines 2-3 from the bottom of claim 1). In this regard, a *prima facie* case of obviousness requires disclosure of all claimed features. *In re Vaeck*. Thus, this rejection has been overcome because Sakai '801 does not disclose all instantly claimed features.

Further, any reference of ethanol and sugar in Sakai '801 is listed as an optional ingredient. In other words, Sakai '801 does not realize or suggest anything critical regarding such optional ingredients and the requisite motivation is thus lacking to achieve what is instantly claimed.

Thus, this rejection under § 103(a) has been overcome, and reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

Applicants have taken substantial steps in advancing prosecution of this case, and a full and complete response has been made to all issues as cited in the Office Action. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Application No. 09/744,678
Art Unit 1616
Reply to Office Action of December 2, 2005

Docket No.: 0425-0821P

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,



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